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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,964	10/12/2000	Geert Maertens	2551-48	5719

7590 02/13/2002

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EXAMINER

TRAN, MY CHAU T

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 02/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/686,964

Applicant(s)

MAERTENS ET AL.

Examiner

My-Chau T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-17, drawn to a solid phase immunoassay, classified in class 435, subclass 7.92.
  - II. Claim 20, drawn to a method for purifying a cysteine, classified in class 436, subclass 177.
  - III. Claims 18-19, drawn to Hepatitis C Virus non-structural 3 protein treated by a method, classified in class 930, subclass 223.
  - IV. Claims 21 (part of) and 22-27, drawn to Hepatitis C Virus polynucleic acid encoding a polypeptide, classified in class 424, subclass 184.1.
  - V. Claims 21 (part of) and 22-27, drawn to Hepatitis C Virus polynucleic acid, classified in class 536, subclass 23.1.
  - VI. Claims 28, 31 and 33-34, drawn to Hepatitis C Virus polypeptide, classified in class 424, subclass 228.1.
  - VII. Claim 29, drawn to Hepatitis C Virus non-structural 3 helicase protein, classified in class 930, subclass 240.
  - VIII. Claim 32, drawn to a method for detecting a polypeptide, classified in class 436, subclass 536.
  - IX. Claim 35, drawn to a method for the production of a polypeptide, classified in class 435, subclass 68.1.

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The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I-IX are unrelated and independent inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions as claimed have different method steps and effects. The feature of a reducing agent of group I is not required by the claims of the other groups. The feature of a zwitterionic detergent of group II is not required by the claims of the other groups. The feature of a Hepatitis C Virus non-structural 3 protein of group III is not required by the claims of the other groups. The feature of a Hepatitis C Virus polynucleic acid encoding a polypeptide of group IV is not required by the claims of the other groups. The feature of a Hepatitis C Virus polynucleic acid of group V is not required by the claims of the other groups. The feature of a Hepatitis C Virus polypeptide of group VI is not required by the claims of the other groups. The feature of a Hepatitis C Virus non-structural 3 helicase protein of group VII is not required by the claims of the other groups. The feature of determining the complex formed of group VIII is not required by the claims of the other groups. The feature of the production of a polypeptide of group IX is not required by the claims of the other groups.
3. Inventions of Group VI and Group IX are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the

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instant case the product as claimed can be made by another and materially different process such as by combining different fragments of polypeptide.

4. Inventions of Group VI and Group VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as the detection method of mass spectrometry.

5. Because these inventions are distinct for the reasons given above and the structure and literature searches required are not co-extensive thus requiring a burdensome search, restriction for examination purposes as indicated is proper. Additionally, different patentability considerations are involved for each group. For example, a patentability determination for Group II would involve a determination of the patentability of the combination of a composition comprised of a detergent while a patentability determination for Group VI would involve a consideration of the patentability of the sequence of the Hepatitis C Virus non-structural 3 helicase protein. These considerations are very different in nature.

6. Each of the sequence IDs of the figures appears to constitute a patentably distinct invention that is, each SEQ. ID. NO. defines a functionally and chemically distinct entity. A prior art reference, which would anticipate or render obvious one sequence ID, would not

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necessarily render obvious any other sequence ID. **Thus, applicants are advised that upon election of any one of Group IV-IX, further restriction/election of species may be required by the examiner to whom the case is assigned for an initial examination on the merits,**

7. Applicants are advised that in accordance with the court decisions in *In re Ochiai*, {71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995)} and *In re Brouwer* {77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996)}, in the event that a product claim is found to be allowable, a method of use claim *which is of the same scope as the allowed product claim* may be rejoined with the allowed product claim.

8. A telephone call was made to Mr. B. J. Sadoff on 1/25/02 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999.

The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on 703-305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

mct  
February 7, 2002

*Mary E. Ceperley*  
**MARY E. CEPERLEY**  
**PRIMARY EXAMINER**  
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